UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,571	12/09/2003	David L. Henrickson	317071.01	5084

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EXAMINER
MANSFIELD, THOMAS L

ART UNIT	PAPER NUMBER
3624	

NOTIFICATION DATE	DELIVERY MODE
06/10/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/731,571	HENRICKSON ET AL.
	Examiner	**Art Unit**	
	THOMAS MANSFIELD	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 January 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10 and 11* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 10, and 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 January 2010 has been entered.

2.   This Continued Examination Office Action is in reply to the Request for Continued Examination filed on 6 January 2010.

3.   Claim 1 has been amended.

4.   Claims 1-8, 10, and 11 are currently pending and have been examined.

Response to Amendment

5.   In the previous office action, Claims 1-8, 10, and 11 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although the Applicant has amended claim 1 to recite *a tool operating on the source computer*, the amendment is insufficient to provide statutory support for Claim 1 and the rejection is maintained and further explained in the below rejection.

Response to Arguments

6.   Applicant's arguments filed 6 January 2010 have been fully considered but they are moot in view

of new grounds of rejection.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or
composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
subject to the conditions and requirements of this title.

8.   Claims 1-8, 10, and 11 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Claim 1 is directed toward the statutory category of a process. In order for a claimed process to

be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular

machine, or (2) transform a particular article to a different state or thing. *See In Re Bilski*, 88

U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S.

584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972).   If neither of these

requirements is met by the claim, the method/process is not patentable subject matter under §

101. Thus, to qualify as a statutory process under § 101, the claim should <u>positively recite</u> the

machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps),

or positively recite the subject matter that is being transformed (e.g. by identifying the material

that is being changed to a different state).   Nominal recitations of structure in an otherwise

ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72.

Thus, incidental physical limitations such as insignificant extra-solution activity and field of use

limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter. For example, Claim 1 should recite statutory subject matter within the body of the claim to fully support the causing, acquiring, recommending, enabling, migrating, installing, and processing steps recited in Claim 1. The step limitations do not recite specific computer architecture processing steps capable of causing computer components and a computer product to be delivered to a physical location. Dependent Claims 2-8, 10, and 11 are rejected for the same reasons and rationale as Claim 1.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 1-6, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrisville-Wolff et al. (Wolff) (U.S. Pub. No. 2003/0041130) in view of Selitrennikoff et al. (Selitrennikoff) (U.S. 6,301,612).

With regard to Claim 1, Linberg teaches *a custom computer acquisition method comprising:*

a) causing the contents of a source computer to be surveyed (assisting an operator of a client device in analyzing their systems and selecting from available patches and upgrades, hardware analysis, analyzing the client system information to select operating system and application upgrades) (see at paragraphs 7, 27-33, and claim 13);

b) *from said surveying, gaining knowledge of the components of said source computer* (available patches and upgrades, hardware analysis, analyzing the client system information to select operating system and application upgrades), *said surveying performed by a tool* (analysis tool) *operating on the source computer, said knowledge comprising an inventory of components* (system and application upgrades) *and user settings and user preferences of the source computer* (system and application upgrades, distribution of services, such as patch analysis and installation, client training, software upgrade installation and recommendation) (see at least paragraphs 7, 20-33, and claim 13);

c) *acquiring upgrade knowledge of a plurality of upgrade products which at least contain an upgrade over one or more of the components of said source computer* (software upgrade installation and recommendation) (see at least paragraphs 7, 20-33);

e) *recommending to said customer at least one upgrade product of a plurality of upgrade products to be installed on said target computer based upon the knowledge of said source computer components and the upgrade knowledge of said plurality of upgrade products, at least some of the plurality of upgrade products corresponding to one or more of the components of said source computer* (system and application upgrades, distribution of services, such as patch analysis and installation, client training, software upgrade installation and recommendation, recommended patches database **284**) (see at least paragraphs 7, 20-33, and 41-44);

f) *enabling said customer to choose at least one upgrade product of a plurality of upgrade products to be installed on said target computer* (allowing a client operator to initiate service requests, to be able to request and receive services managed or controlled by the service manager **240**, service deployment mechanism **256**) (see at least paragraphs 37-41);

g) *migrating to said target computer at least some of the inventory of components of the source computer, and at least some of the user settings of the source computer, and at least some of the user preferences of the source computer* (allow efficient, automatic service provision to a client server) (see at least paragraphs 45-49);

h) installing the chosen at least one upgrade products on said target computer (The installation then preferably continues automatically without further operator input) (see at least paragraphs 45-49);

i) processing said order (the service manager **160** which functions to respond to service requests by selecting and providing services to the requesting client systems **104**, **116**)) (see at paragraphs 21-29);

Wolff teaches *d) receiving an order* (receive service requests from clients, virtual service mechanism **108**) *for a new target computer from a customer having dominion over said source computer* (see at paragraphs 21-29). However, Wolff does not specifically teach *a new target computer*. Selitrennikoff teaches *a new target computer* (a new computer or new or replacement hardware) in analogous art of computer replacement for the purposes of, "booting a client computer over a network" (see at least column 6, lines 6-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the establishing one computer as a replacement for another computer method as taught by Selitrennikoff with the service provider system of Wolff. One of ordinary skill in the art would have been motivated to do so for the benefit of compensating for a new computer or new or replacement hardware before the operating system boots on the client computer (Selitrennikoff, see at least 6, lines 6-56).

Wolff teaches *j) following elements h) and i), causing a custom target computer to be delivered to said customer or said customer's agent* (the service manager **240** initiates patch and upgrade delivery services **274** by delivering the patch and upgrade delivery proxy **260** for execution, installation). Wolff does not specifically teach *a custom target computer*. Selitrennikoff teaches *a new target computer* (a new computer or new or replacement hardware) in analogous art of computer replacement for the purposes of, "booting a client computer over a network" (see at least column 6, lines 6-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the establishing one computer as a replacement for another computer method as taught by Selitrennikoff with the operational and functional software upgrading method of Linberg. One of ordinary skill in the art would have been motivated to do so for the benefit of compensating for a new computer or new or replacement hardware before the operating system boots on the client computer (Selitrennikoff, see at least 6, lines 6-56).

With regard to Claim 2, Wolff teaches *wherein said source computer components comprise a user state* (system maintenance) (see at least paragraph 27).

With regard to Claim 3, Wolff teaches *downloading a software tool* (service proxies) *from a remote location onto said source computer* (see at least paragraphs 30-38); *and carrying out elements a) through i) with the aid of said software tool* (see at least paragraphs 30-38).

With regard to Claim 4, Wolff teaches *wherein said software tool is an instrumentality under the dominion of a computer software and hardware vendor* (service providers **136**, **148** are linked to the communications network **132** to allow communications with the service manager **160** and direct communication with the client systems **104**, **116** when providing a service) (see at least paragraph 27).

With regard to Claim 5, Wolff teaches: *loading a software tool onto said source computer* (Jini™ technology-enabled service, service proxies) (see at least paragraphs 26-38); *and carrying out elements a) through i) with the aid of said software tool* (see at least see at least paragraphs 26-38); *wherein said software tool is an instrumentality under the dominion of a computer software and hardware vendor, and wherein said upgrade products are directly available from said vendor* (see at least see at least paragraph 27).

With regard to Claim 6, Wolff teaches: *loading a software tool onto said source computer* (see at least see at least paragraphs 26-38) *and carrying out elements a) through i) with the aid of said software tool* (see at least see at least paragraphs 26-38); *wherein said software tool is an instrumentality under the dominion of a computer software and hardware vendor, and wherein said upgrade products are available via an Internet link to an instrumentality of a separate entity from said vendor* (virtual service network, Internet, LAN, WAN) (see at least paragraphs 23-24).

With regard to Claim 8, Wolff teaches *loading a software tool onto said source computer from a local storage medium comprising said software tool and product upgrades* (storage **184**)*; and carrying out elements a) through i) with the aid of said software tool* (see at least paragraphs 26-35).

With regard to Claim 10, Wolff teaches *activating at least one installed upgrade product via a telecommunication link* (communications network **132**) (see at least paragraph 23).

With regard to Claim 11, Wolff teaches *wherein said upgrade products comprise software* (received executable code) (see at least paragraph 24).

11.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff and Selitrennikoff as cited above in Claims 1-6, 8, 10 and 11 and in further view of Fawcett (U.S. 6,073,214).

With regard to Claim 7, Wolff and Selitrennikoff do not specifically teach *said computer software and hardware vendor receives remuneration from said separate entity when an upgrade product is received from said instrumentality of said separate entity.* Fawcett teaches *said computer software and hardware vendor receives remuneration from said separate entity when an upgrade product is received from said instrumentality of said separate entity* in analogous art of computer software updating for the purposes of, "once the fee information is collected by the update service computer and is verified, the user can choose between immediate or delayed downloading of the new or new version of the computer software" (see at least column 10, lines 15-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and system for identifying and obtaining computer software for a remote computer as taught by Fawcett with the establishing one computer as a replacement for another computer method as taught by Selitrennikoff with the service provider system of Wolff. One of ordinary skill in the art would have been motivated to do so for the benefit of relieving the user from the burden of installing the computer software and obtaining up-to-date versions and service (Fawcett, see at least column 10, lines 43-63).

Conclusion

12.   The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Slivka et al. (U.S. 6,256,668) discloses a method for identifying and obtaining computer software from a network computer using a tag.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4 June 2010

/Thomas Mansfield/
Examiner, Art Unit 3624